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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,308	03/20/2001	L. Dudley Eirich	U 0016 OS/OAPT	2258

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COGNIS CORPORATION
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EXAMINER

LILLING, HERBERT J

ART UNIT	PAPER NUMBER
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1651

13

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,308

Applicant(s)

EIRICH ET AL.

Examiner

HERBERT J LILLING

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2002 and 11 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,14 and 16-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 5,6,14 and 16-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Receipt is acknowledged of the election filed July 16, 2002 and the IDS filed September 11, 2002.

2. Applicant has elected with traverse Group I, claims 1-15 for examination.

Claims 5, 6, 14 and 16-30 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9 dated July 16, 2002.

The arguments have been deemed not to be persuasive since the search and examination requires a totally different search and examination based on the search in the shoes as well as any computerized search, which requires different end products. The restriction requirement was proper as stated in the previous office action and has been made final.

Claims 1-4, 7-13 and 15 are drawn to the elected Invention and species.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE4015851, and Liu et al, Computer Abs

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1993:233484 or in the alternative as being obvious over DE4015851 further in view of Turner, U.S. 6,288,275 or U.S. Mobley et al U. S. 6,004,784 for the strains of claims 8-10.

Claims **1-3 and 7, 8,10-11 are anticipated by DE4015851** which teaches the same substrate in example 1 as well as the advantages of employing the use of well known mutants which interrupt the beta-oxidation pathway, see page 4. The reference also teaches the employment of an organic solvent prior to the fermentation, see page 5.

Claims **12 and 15 are rejected under 35 U.S.C. 102(b)** as anticipated by Liu et al, Computer Abs 1993:233484. Liu et al teaches the production of a carboxylic acid employing dodecene as the substrate.

Claims **4, 9 and 13 are rejected under 35 U.S.C. 103(a)** obvious over DE4015851 or Liu et al further in view of obvious over U.S. 5,620,878 or U.S. 5,648,247. It would have been prima facie obvious to employ the strains disclosed by Mobley et al U.S. 6,004,784 [column 2, lines 25-45] or Turner U. S. 6,288,275, for those of DE4015851 or Liu et al as well as adding a solvent in view of the teachings of Turner


“....to enhance phase separation, an organic solvent may be added to the fermentation broth prior to.....adjusting the pH of the broth. Suitable solvents are those with minimum water solubility and maximum solubility of the carboxylic acid in the organic phase. Suitable organic solvents include, but are not limited to, aliphatic hydrocarbons, aromatic hydrocarbons, aldehydes, ketones, ethers, alcohols, esters, acids, amides, amines and halogenated hydrocarbons. “

4. **No claim is allowed.**

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is (703) 308-2034** and **Fax Number** is for applications **Before Final** (703) 872-9306 and **After Final** for applications is 703-872-9307 or SPE Michael Wityshyn whose telephone number is (703) 308-4743. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL
(703) 308-2034
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June 02, 2003


Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1651